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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/631,542 08/03/00 IMANAKA

R MAT-3720US3

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WM01/0207

EXAMINER

RATNER & PRESTIA  
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VALLEY FORGE PA 19482

GRANT

ART UNIT

PAPER NUMBER

2611

DATE MAILED:

02/07/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No. <b>09/631,542</b>	Applicant(s) <b>IMANAKA</b>
Examiner <b>Christopher Grant</b>	Group Art Unit <b>2611</b>

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

- Claim(s) 14-16 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 14-16 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been
- received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). 1,5
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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## **DETAILED ACTION**

### ***Reissue Applications***

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

The original ribboned copy of the patent has not been surrendered. See MPEP 1416.

### ***Specification***

2. There are several re-issue applications for patent 5790172 (patented application 08/503604). The current re-issue application must be amended to include a cross reference to all the other related re-issue applications for the patent at line 1 of the first page of the specification.

### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- (a) It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

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(b) The oath or declaration must state that "*all errors being corrected in the reissue application up to the time of the filing of the oath or declaration arose without any deceptive intention on the part of the applicant*". See 37 CFR 1.175 (a)(2).

4. Claims 14-16 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

*Note to applicant*

5. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.121(b).

6. The references listed on form 1449 sent with the Information Disclosure Statement (received 1/29/2001) has not been considered by the examiner because the references are not in the related application file 09/594,192. Applicant should provide the references for consideration by the examiner.

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***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Horton et al. disclose a television system having different three modes: a) view only; b) view and tape for fee; and c) view and tape for free. See column 3.

Yoshizawa et al., Schuchman and Russo disclose billing for recording in a CATV system.

Verduin discloses different fees for playing a record and viewing a video.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 4700.

*Christopher Grant*  
**Christopher Grant**  
**Primary Examiner**  
**February 2, 2001**